

Applicants: Andrew P. Muser  
Serial No.: 10/674,483  
Filing Date: September 30, 2003  
Docket No.: P-4961/2 (102-405)  
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### **REMARKS**

Reconsideration of the application is respectfully requested.

Claims 1-9 are in the application.

#### **I. Rejection of Claims 1-4 and 8-9 under 35 U.S.C. §103(a) over Szlosek or Pham et al.**

In the Official Action, the Examiner rejected claims 1-4 and 8-9 under 35 U.S.C. §103(a) as being allegedly unpatentable over Szlosek (U.S. Patent No. 5,759,494) or Pham et al. (U.S. Patent No. 6,063,338). In formulating the rejection, the Examiner stated "Szlosek and Pham do not specifically teach that the corners of the wells should be rounded. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed wells having rounded corners in the apparatus of Szlosek or Pham, in order to facilitate cleaning of the wells."

The Examiner's assertions are respectfully traversed.

Szlosek is directed to a microplate having an array of wells 12. As noted by the Examiner, at column 4, lines 8-14, the Szlosek reference states,

In the illustrative embodiment shown, the wells 12 have circular cross-sections in a plane parallel to the planar surface 13. However, the invention is not limited in this respect, and it should be understood that wells 12 may be provided in a number of alternate configurations having different cross-sectional shapes, e.g., rectangles, squares and triangles.

Only circular cross-sectionally shaped wells 12 are shown in the figures, particularly in Figures 1 and 2. The wells 12 are also shown only to have constant cross-sections from top to bottom without any tapering.

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Pham et al. is directed to a multi-well plate which includes wells 10, 40 (column 2, lines 36-41). The figures only show a circular cross-sectional well which is tapered convergently towards the bottom of the plate. As noted by the Examiner, Pham et al. states at column 7, lines 31-37,

Wells can be made in any cross-sectional shape (in plan view) including, square, round, and hexagonal and combinations thereof. Wells can be made in any cross sectional shape (in vertical view) including, shear vertical walls with flat or round bottoms, conical walls with flat or round bottoms and curved vertical walls with flat or round bottoms and combinations thereof.

A *prima facie* showing of obviousness requires three elements:

1. some suggestion or motivation to modify a reference;
2. a reasonable expectation of success; and,
3. the reference must teach or suggest all of the claim limitations.

MPEP §2143.

It is respectfully submitted that the Examiner has failed to satisfy at least the first and third requirements of a *prima facie* showing of obviousness.

**A. All of the claim limitations are not present in the prior art**

As set forth in MPEP §2143.03, “[t]o establish *prima facie* obviousness of a claimed invention, **all the claim limitations** must be taught or suggested by the prior art.”

(Emphasis applied). Claim 1 is directed to a multiwell plate having a plurality of wells, “at least a portion of said wells each being formed with an open end, a closed end and a side wall extending therebetween”, “said side wall including four spaced-apart rectangular

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panels and four rounded corners, each of said corners located to join, and extend between, a pair of adjacent said panels.” As admitted by the Examiner, the claimed rounded corners are not disclosed in either Szlosek or Pham et al. The generic discussions in Szlosek and Pham et al. do not provide the specific claimed arrangement of the rounded corners and, thus, this limitation is not present therein. The Examiner has not presented any prior art which specifically shows rounded corners and, thus, has not provided any prior art which discloses each and every limitation of claim 1.

Admittedly, and as set forth in MPEP §2144.04, legal precedent may be relied upon to modify a reference as a basis for an obviousness rejection. Specifically, MPEP §2144.04 (IV)(B) indicates that changes in shape from a prior art reference may be alone not patentable. However, as noted in MPEP §2144.04, legal precedent is not to be used where an “applicant has demonstrated the criticality of a specific limitation”. With reference to Paragraph [0004] of the subject specification, the rounded corners of the subject invention provide less wicking and enable larger perimeters to be defined along the length of the wells. The rounded corners do not just provide a change in shape, but have critical, meaningful purposes. Thus, reliance on legal precedent alone in formulating a *prima facie* obviousness rejection is not proper. Without any prior art to combine with Szlosek or Pham et al., there is no disclosure or suggestion of the rounded corners in Szlosek or Pham et al.

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**B. No motivation to modify Szlosek or Pham et al. as suggested by the Examiner**

A *prima facie* case of obviousness also requires some suggestion or motivation to modify the reference. See MPEP §2143. As stated in MPEP §2143.01, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” The Examiner’s basis for modifying Szlosek or Pham et al. is “to facilitate cleaning of the wells.” There is no proof that the rounded corners will in fact facilitate cleaning and, thus, no indication of the desirability of the modification proposed by the Examiner. Accordingly, there is no motivation to modify Szlosek or Pham et al. as suggested by the Examiner. Without a basis for modifying the references as suggested by the Examiner, there cannot be a *prima facie* showing of obviousness.

In view of the foregoing, it is respectfully submitted that claim 1, along with dependent claims 2-4 and 8-9, are patentable over Szlosek and Pham et al.

**II. Rejection of claims 6-7 under 35 U.S.C. §103(2) over Szlosek**

The Examiner rejected claims 6-7 under 35 U.S.C. §103(a) as being allegedly unpatentable over Szlosek. The Examiner pointed in Szlosek to a discussion of a prior art reference which refers to bonding upper and lower plates in forming a microplate.

Claims 6 and 7 depend from claim 1. It is respectfully submitted that, for the reasons set forth above, claims 6 and 7 are also patentable over Szlosek.

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**III. Rejection of claims 1-5 and 8-9 under 35 U.S.C. §103(a) over Kowallis et al.**

The Examiner rejected claims 1-5 and 8-9 under 35 U.S.C. §103(a) as being allegedly unpatentable over Kowallis et al. (U.S. Patent No. 6,878,341). The Examiner stated that "Kowallis does not specifically teach that the corners of the wells should be rounded. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed wells having rounded corners in the apparatus of Kowallis, in order to facilitate cleaning of the wells."

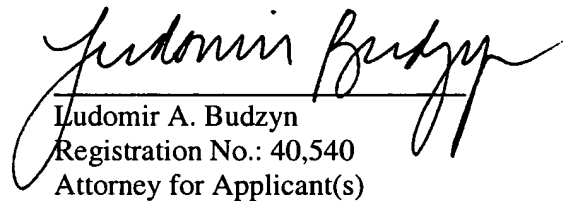
Kowallis et al. is directed to an apparatus which includes a plate 112 having a plurality of wells 114 formed therein. The Examiner cited figure 12 of Kowallis et al. in the rejection. Figure 12 shows the wells 114 with a square or rectangular cross-section defined by trapezoidal sidewalls.

For the same reasons noted above, Kowallis et al. does not disclose or suggest the use of rounded corners in its wells 114. There is no written description or figure showing such a structure. Moreover, there is no motivation to modify the design as suggested by the Examiner since the desirability of rounded corners has not been shown by the Examiner. In addition, Kowallis et al. lacks rectangular side walls, as set forth in claim 1. The side walls 114 are not rectangular but, rather, are trapezoidal in shape. It is respectfully submitted that claims 1-5 and 8-9 are patentable over Kowallis et al.

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Favorable action is earnestly solicited. If there are any questions or if additional information is required, the Examiner is respectfully requested to contact Applicant's attorney at the number listed below.

Respectfully submitted,

  
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